

**REMARKS**

Claims 1-43 are pending. Applicant thanks Examiner for his indication that claims  
Claims 1-8, 11 and 12 are in condition for allowance.

**I. Information Disclosure Statement**

Examiner noted that an information disclosure statement filed on August 21, 2003 failed to comply with 37 C.F.R. 1.98(a)(2) due to the fact that an English translation was not provided for EP 0 550 342. United States Patent No. 5,312,451 to Limousin, a United States counterpart to the cited European patent which was disclosed in that same August 21, 2003 information disclosure statement, is an accurate English translation of the European patent disclosure.

**II. Claim rejections under 35 U.S.C. § 112**

Claims 9, 10, 16, 21, 22, 36-38, 42, and 43 were rejected under 35 U.S.C. § 112. Applicant has made several amendments to the claims at issue to clear up these issues. These amendments include: amending limitations to correctly recite "the stimulation energy" instead of "the energy stimulation" in claims 9, 21, 31, and 40; replacing "the atrio-ventricular conduction delay" with "an atrio-ventricular conduction delay" in claim 16; and removing "suspected loss of atrial detection" from claim 33 as indicated by the Examiner. For these reasons, Applicant respectfully asks the Examiner to withdraw the grounds for this rejection.

**III. Claim rejections under 35 U.S.C. § 102**

Claims 13-15, 17, 23, 24, 26, and 33-35 have been rejected as anticipated by Lu et al. (U.S. Patent No. 5,476,486) and claims 13-15, 19, 20, 28-30, 33-35, and 39 have been rejected as anticipated by Markowitz et al. (U.S. Patent No. 5,601,615). Applicant respectfully traverses the grounds for these rejections.

Independent claims 13, 23 and 33 have been amended to include a "means for automatic mode commutation" and the additional limitation that said conditions are detected "in order to prevent inappropriate switching to a DDD pacing mode." Neither Lu nor Markowitz disclose any means for automatic mode commutation whereby such conditions are detected in order to prevent inappropriate switching to a DDD pacing mode. Instead, Markowitz discloses a method for adjusting the atrial capture threshold and Lu discloses an automatic atrial pacing pulse threshold determination utilizing an external programming device. Although both Markowitz and Lu may disclose various methods of suspecting loss of atrial capture, neither of them disclose detecting such conditions in order to prevent inappropriate switching to a DDD pacing mode.

"[A] claim is anticipated if each and every limitation is found either expressly or inherently in a single prior art reference." *Celeritas Techs., Ltd. v. Rockwell Int'l. Corp.*, 150 F.3d 1354, 1361, 47 U.S.P.Q.2d 1516, 1522 (Fed. Cir. 1998). The standard for lack of novelty, that is, for "anticipation," is one of strict identity. *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1296, 63 U.S.P.Q.2d 1597, 1600 (Fed. Cir. 2002). Because neither Lu nor Markowitz disclose analyzing the claimed conditions in order to prevent inappropriate switching to a DDD pacing mode, Applicant believe they do not anticipate the present invention. For this reason, the Applicant respectfully asks that the Examiner withdraw these rejections of claims 13-15, 17, 23, 24, 26, and 33-35 (with respect to Lu) and claims 13-15, 19, 20, 28-30, 33-35, and 39 (with respect to Markowitz).

#### **IV 35 U.S.C. § 103(a) Rejections**

Claims 30-32 and 39-41 have been rejected as obvious in view of Bornzin et al. (U.S.

**PATENT**

Attorney Docket No. 8707-2160  
163A – Gestion Capteur  
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Patent No. 6,389,316) and Markowitz. Applicant respectfully traverses the grounds for this rejection in view of the above amendments to the claims and the following remarks.

To establish a *Prima Facie* case of obviousness, there must be: (1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine references teachings; (2) a reasonable expectation of success; and (3) prior art references which teach or suggest all of the claim limitations. See *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000); MPEP § 2143 (8th Ed., Rev. 1).

In the present invention, independent claims 28 and 33 have been amended to include a "means for automatic mode commutation" and the additional limitation that said conditions are detected "in order to prevent inappropriate switching to a DDD pacing mode." As discussed above, although Markowitz may disclose various methods of suspecting loss of atrial capture, it fails to disclose detecting such conditions in order to prevent inappropriate switching to a DDD pacing mode. Similarly, Bornzin also discloses a means for suspecting loss of atrial capture, but it also does not disclose detecting such conditions in order to prevent inappropriate switching to a DDD pacing mode. For this reason, Markowitz and Bornzin, when viewed in combination or alone, fails to teach or suggest all of the claim limitations in claims at issue in the present application.

Additionally, neither the Markowitz nor Bornzin reference would motivate one to modify either reference to include the "means for automatic mode commutation" and the additional limitation that said conditions are detected "in order to prevent inappropriate switching to a DDD pacing mode" as claimed in the present invention. Instead, both Markowitz

and Bornzin disclose methods directed towards an entirely different function. In the case of both Markowitz and Bornzin, methods are disclosed for adjusting the atrial capture threshold. Neither would motivate one of ordinary skill in the art to modify either reference to include the limitation noted above.

For the foregoing reasons, Applicant believes Claims 30-32 and 39-41 are now in condition for allowance.

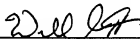
**CONCLUSION**

Reconsideration of this application in view of the foregoing remarks respectfully is requested.

The Examiner is invited to call Applicant's undersigned attorney if doing so would expedite prosecution.

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Respectfully submitted,

  
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